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IN THE

SUPREME COURT

OF THE

UNITED STATES.

OCTOBER TERM, 1923.

Number 315.

Clarence D. Keller and Arthur C. Lillie, Doing Business as Hartford Windshield Company,
Petitioners-Plaintiffs,

vs.

Adams-Campbell Company, Inc. (a Corporation), T. R. Gabel, A. F. Kipper, Individually, and A. F. Kipper Doing Business as Kipper & Co.; Harry W. Hahn, Doing Business as Harry W. Hahn Manufacturing Company, and Augustine S. Lockwood, Individually, and Augustine S. Lockwood Doing Business as Kozy Wing Auto Supply Company,
Respondents-Defendants.

Brief on Behalf of Respondents-Defendants on Final Hearing.

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Parker, Stone & Baird Co., Law Printers, Los Angeles.

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Respondents-Defendants.

Brief on Behalf of Respondents-Defendants on Final Hearing.

[In the following brief we shall refer to petitioner as plaintiff and to our clients the respondents, as defendants.

For the purpose of emphasizing the salient portion of some of the decisions we have utilized italics.]

Introduction.

This case comes before this court upon writ of certiorari solely upon the ground that there is a sharp conflict between the courts of the several circuits as to the law applicable to reissue patents in connection with the defense of intervening rights.

The patent at issue has not been involved in any litigation outside the Ninth Circuit, and the district judge who tried the case and the three judges of the Circuit Court of Appeals who heard the appeal are quite unanimous as to the facts of the case and as to the application of the law thereto.

We believe the only question in which this court is interested is the broad question of the state of the law as to reissues in which intervening rights are set up as a defense, and whether, in view of this law, this case was correctly decided in the court below. We will direct our brief solely to these questions.

We did not oppose the petition for the writ of certiorari, as we did not think that the court would desire to review this question at this time. We do not, however, agree with the petitioner that there is any sharp conflict of law on the questions to be considered.

After trying several cases involving intervening rights, in some of which we have had

reissued patents sustained, we are impressed with consistency of all the decisions from the various Federal courts who have dealt with this subject. The underlying principles relating to intervening rights seem to have been understood by all the judges in the reported cases, and to have been consistently applied in *all* the reported cases. Instead of there being a sharp conflict as to the law between the judges of the various Circuit Courts of Appeal, as alleged in the petition for the writ of certiorari, it seems to us that all the reported decisions which consider intervening rights, if properly interpreted, form a harmonious whole. In fact, we know of no branch of Federal practice in which our courts appear to better advantage than in their treatment of this difficult matter of intervening rights.

THE FACTS.

The facts in this case are as follows:

The defendants were engaged in the development of windshield wings for some time prior to the issue of the original Keller patent, the reissue of which is here to be considered. At the time the original Keller patent issued, or perhaps slightly after that time, our clients were considering the manufacture in quantity of such a windshield wing. When they discovered that the Keller patent had issued, they visited the

attorney who had obtained the patent for Keller and submitted to him the windshield wing defendants proposed to make, asking him if he considered it an infringement of the Keller patent. The windshield wing submitted was that now alleged to be an infringement. The attorney for Keller advised our clients that this windshield wing did not infringe the original Keller patent. This advice has since been judicially declared to be correct. The original Keller patent contained only three claims, which appear in the reissue as the first three claims thereof. These claims are quite specific to "brackets engaging the glass at the upper and lower ends," and obviously this structure is not present in defendants' device, in which the glass is secured to the frame by bolts which pass through the glass. Defendants, therefore, acting upon the advice of the solicitor who prosecuted the original Keller patent, and upon whose advice they were certainly justified in relying, proceeded to embark in the business of making windshield wings, and there will be found in the record very complete documentary and oral proof showing that prior to the application for reissue of the Keller patent, our clients had made tools and dies and were actually embarked on the business of making windshield wings that did not infringe the original Keller patent.

We note, however, that the greater portion of plaintiff's brief is devoted to questions of fact. We do not understand that this is an appeal from a decision as to the facts, and since we find it necessary to devote considerable space to the consideration of the questions of law raised in plaintiff's petition, we believe it best to rest our case as to the facts on the findings of the trial court and the Court of Appeals, which concurred in such findings. These findings are abundantly supported by the evidence and we are sure will not be disturbed by this court merely upon statements in plaintiff's brief.

We cannot understand, however, upon what theory plaintiff petitions for a writ on the ground that there is confusion of *law*, and then files a brief directed almost wholly to the *facts*.

Anything Disclosed But Not Claimed in a Patent Is Dedicated to the Public.

This principle has become so well established that it is almost elementary. It was very clearly stated by this court as follows:

> "The public is notified and informed by the most solemn act on the part of the patentee that his claim to invention is for such and such an element or combination, and nothing more. Of course, what is not claimed is public property. The presumption is, and such is generally the fact, that what is not claimed was not invented by

> the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not so before. The patent itself, as soon as it is issued, is the evidence of this."
>
> Mahn v. Harwood, 112 U. S. 354, 28 L. Ed. 665.

This was approved in Underwood v. Gerber, 149 U. S. 224, 37 L. Ed. 710.

The principle was not original with Mahn v. Harwood, but was well established prior to that time, being well stated in the "Corn Planter Patent" case, 23 Wall. 181, 23 L. Ed. 161, and repeatedly applied by the courts.

On Nov. 2, 1891, this court said:

> "Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public."
>
> McClain v. Ortmayer, 141 U. S. 424, 35 L. Ed. 800.

This was later approved in Deering v. Winona Harvester Works, 155 U. S. 286, 39 L. Ed. 153.

The principle has been further applied in many decisions of the lower courts, being very well stated as follows:

"The statute requires the inventor to particularly point out and to claim distinctly the improvement or combination which he claims as his discovery. Rev. St., Sec. 4888. When, under this statute, the inventor has made his claims, he has thereby disclaimed and dedicated to the public all other combinations and improvements apparent from his specification and claims that are not mere evasion of the device, combination, or improvement which he claims as his own. While the patent is notice of the claims which it contains and allows, *it constitutes an estoppel of the patentee from claiming under that or any subsequent patent any combination or improvement there shown* which he has not clearly pointed out and distinctly claimed as his discovery or invention when he received his patent. It is a complete and a legal notice to everyone—notice on which everyone has a right to rely—that he may freely use such improvements and combinations without claim or molestation from the patentee."

McBride v. Kingman, 97 Fed. 217.

The above is also quoted practically *verbatim* in Royal Co. v. Tweedie, 276 Fed. 351, which also cites Valvona-Marchiony Co. v. Perella, 212 Fed. 168.

In the present case the plaintiff in the original Keller patent claimed a windshield wing in which the glass shield member was supported in "brackets engaging said member at its upper and lower ends," that is, in the channel-

shaped members 17 and 18. All three claims were directed to this feature. By the issuance of the original Keller patent plaintiff dedicated to the public the right to make windshields, like those of defendants, in which the glass was not supported in such brackets.

Equitable Estoppel Is a Principle Often Applied to Many States of Fact.

The principle of equitable estoppel is not peculiar to patent law, but has a very wide application. This court has stated that

> "it often gives triumph to right and justice where nothing else known to our jurisprudence can, by its operation, secure those ends. Like the Statute of Limitations, it is a conservator, and without it society could not well go on."
>
> Daniels v. Tearney, 12 Otto 415, 26 L. Ed. 187. Decided Dec. 13, 1880.

It has been repeatedly applied not only in patent matters, but in all sorts of cases. It is not necessary for us to attempt to restate it, as the court has many times clearly defined it. See, for example, the following:

> "Where a person tacitly encourages an act to be done, he cannot afterwards exercise his legal right in opposition to such consent, if his conduct or acts of encouragement induced the other party to change his position, so that he will be pecuniarily

prejudiced by the assertion of such adverse claim."

Swain v. Seamens, 9 Wall. 254, 19 L. Ed. 554. Decided Jan. 24, 1870.

"If one person is induced to do an act prejudicial to himself in consequence of the acts or declarations of another, on which he had a right to rely, equity will enjoin the latter from asserting his legal rights against the tenor of such acts or declarations."

Branson v. Wirth, 17 Wall. 32, 21 L. Ed. 566. Decided Mar. 3, 1873.

"The estoppel here relied upon is known as an equitable estoppel, or estoppel *in pais*. The law upon the subject is well settled. The vital principle is, that he who, by his language or conduct, leads another to do what he would not otherwise have done, shall not subject such person to loss or injury by disappointing the expectations upon which he acted. Such a change of position is sternly forbidden."

Dickerson v. Colgrove, 100 U. S. 578, 25 L. Ed. 618. Decided Jan. 12, 1880.

"These cases are referred to for the purpose of showing some of the circumstances under which the courts, to promote the ends of justice, have sustained the general principle that where a duty is cast upon a person, by the usages of business *or otherwise*, to disclose the truth (which he has the means, by ordinary diligence, of ascertaining), and he neglects *or omits* to discharge that duty, whereby another is mis-

led in the very transaction to which the duty relates, he will not be permitted, to the injury of the one misled, to question the construction rationally placed by the latter upon his conduct."

Leather Mfgrs. Nat. Bank v. Morgan, 117 U. S. 96, 29 L. Ed. 811.

"Parties must take the consequences of the position they assume. They are estopped to deny the reality of the state of things which they have made appear to exist, and upon which others have been led to rely."

Casey v. Galli, 94 U. S. 673, 24 L. Ed. 168.

"It is fitly denominated an equitable estoppel because it rests upon the doctrine that it would be against the principles of equity and good conscience to permit the party against whom the estoppel is sought to avail himself of what might otherwise be his undisputed rights."

Stone v. Bank of Commerce, 174 U. S. 412, 43 L. Ed. 1028 at 1034.

"Estoppel ordinarily proceeds upon principles which prevent one from denying the truth of statements upon which others have acted, where the denial would have the effect to mislead them to their prejudice."

Arizona *ex rel.* Gaines v. Copper Queen C. M. Co., 233 U. S. 87, 58 L. Ed. 863.

"The only case in which a representation as to the future can be held to operate as an estoppel is where it relates to an

intended abandonment of an existing right, and is made to influence others, and by which they have been induced to act."

Union Mut. L. Ins. Co. v. Mowry, 96 U. S. 544, 24 L. Ed. 674.

It is evident from the above that the principle of estoppel is not in any way peculiar or restricted to patent cases. It is a broad general principle many times applied by this court in many varieties of actions and to many states of fact. Its use in patent cases is only one of its many applications.

Intervening Rights Depend Upon the Principle of Equitable Estoppel and Arise Whenever Anyone Accepts the Dedication to the Public in any Patent and Acts in Such a Manner as to Avoid the Claims of this Patent Although Infringing a Later Reissue.

The original case on intervening rights is Miller v. Brass Co., 104 U. S. 350, 26 L. Ed. 783. In that decision, decided January 9, 1882, the court said:

"The power given by the law to issue a new patent upon the surrender of the original, for the correction of errors and mistakes, has been greatly misunderstood and abused."

The court then reviewed the history of reissues and finally said:

> "At all events, we think it clear that it was not the special purpose of the legislation on this subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims, although, under the general terms of the law, such a reissue may be made where it *clearly appears* that an actual mistake has inadvertently been made. But, by a curious misapplication of the law, it has come to be principally resorted to for the purpose of enlarging and expanding patent claims. And the evils which have grown from the practice have assumed large proportions. Patents have been so expanded and idealized, years after their first issue, that hundreds and thousands of mechanics and manufacturers, who had just reason to suppose that the field of action was open, have been obliged to discontinue their employments, or to pay an enormous tax for continuing them."

The court then went on and said:

> "Now whilst, as before stated, we do not deny that a claim may be enlarged in a reissued patent, we are of opinion that this can only be done when *an actual mistake* has occurred; not from a mere error of judgment, for that may be rectified by appeal, but a real, *bona fide* mistake, inadvertently committed; such as a court of chancery, in cases within its ordinary jurisdiction, would correct. Reissues for the enlargement of claims should be the exception and not the rule. And when, if a claim is too narrow, that is, if it does not

contain all that the patentee is entitled to, the defect is apparent on the face of the patent, and can be discovered as soon as that document is taken out of its envelope and opened, there can be no valid excuse for delay in asking to have it corrected. Every independent inventor, every mechanic, every citizen, is affected by such delay, and by the issue of a new patent with a broader and more comprehensive claim. The granting of a reissue for such a purpose, after an unreasonable delay, is clearly an abuse of the power to grant reissues, and may justly be declared illegal and void. *It will not do for the patentee to wait until other inventors have produced new forms of improvement, and then, with the new light thus acquired, under pretense of inadvertence and mistake, apply for such an enlargement of his claim as to make it embrace these new forms.* Such a process of expansion, carried on indefinitely, without regard to lapse of time, would operate most unjustly against the public, and is totally unauthorized by the law. In such a case, even he who has rights, and sleeps upon them, justly loses them.

The correction of a patent by means of a reissue, where it is invalid or inoperative for want of a full and clear description of the invention, cannot be attended with such injurious results as follow from the enlargement of the claim. And hence a reissue may be proper in such cases, though a longer period has elapsed since the issue of the original patent. But in reference to reissues made for the purpose of enlarging the scope of the patent, the rule of laches should be strictly applied; and no one should be relieved who has slept upon his

> rights, and has thus led the public to rely on the implied disclaimer involved in the terms of the original patent. And when this is a matter apparent on the face of the instrument upon a mere comparison of the original patent with the reissue, it is competent for the courts to decide whether the delay was unreasonable, and whether the reissue was, therefore, contrary to law and void."

In this case, what has since come to be known as the two-year rule was first expressed as follows:

> "If two years' public enjoyment of an invention with the consent and allowance of the inventor, is evidence of abandonment, and a bar to an application for a patent, a public disclaimer in the patent itself should be construed equally favorable to the public."

Miller v. Brass Co. has probably been relied upon to invalidate more patents than any other one decision. Rose's Notes cite eighteen Supreme Court cases and many more cases in the lower courts, in which it has been followed.

Since, in the particular case decided, there was gross laches, Miller v. Brass Co. was decided on this point and is usually cited as defining the two-year rule. It nevertheless, as pointed out above, clearly recognized the principle of intervening rights which later cases have more fully defined.

Following the two-year rule set up in Miller v. Brass. Co. and many times since sustained by this court, it is definitely settled that any broadened reissue applied for more than two years after the issue of the original patent is void.

In Clements v. Odorless Excavating Co., 109 U. S. 641, 27 L. Ed. 1060, the court further recognized such rights in the following words:

> "The expansions in claims 1 and 3 of the reissue were afterthoughts, *developed by the subsequent course of improvement in the Scharf and Frazier patents, and intended to cover matters appearing in those patents and not claimed in the original patent*, No. 115,565. No excuse is given for the delay in applying for the reissue, nor is any actual inadvertence, accident or mistake shown. The omission to claim sub-combinations in the combinations claimed, the existence of such sub-combinations being apparent on the face of the original patent, was, in law, on the facts in this case, such a dedication of them, if new, to the public, that a reissue, to cover such sub-combinations, in revocation of such dedication, cannot be availed of *to the prejudice of rights acquired by the public to what is shown in the Scharf and Frazier patents*, issued before the reissue was applied for. The reissued patent must, for these reasons, be held to be invalid as to claims 1 and 3."

Since, however, the original patent, No. 115,565, referred to in the above citation, was

issued on June 6, 1871, and the reissue was applied for on January 11, 1876, it is evident that the two-year rule alone would have furnished sufficient ground for the decision and that no doctrine of intervening rights was necessary to a determination of the case. It is evident, however, that the court in this case again recognized the rights of the public as intervenors.

The law of intervening rights was further developed in Coon v. Wilson, 113 U. S. 268, 28 L. Ed. 963. In this case the court said:

> "The final decree in this case was entered July 28, 1881. The decisions of this court in Miller v. Brass Co., 104 U. S. 350, and James v Campbell, 104 U. S. 356, were made January 9, 1882. Under those decisions and many others made by this court since, the 1st and 4th claims of the reissue cannot be sustained. Although this issue was applied for a little over three months after the original patent was granted, the case is one where it is sought merely to enlarge the claim of the original patent, by repeating that claim and adding others; where no mistake or inadvertence is shown, so far as the short or sectional bands are concerned; *where the patentee waited until the defendants produced their continuous band collar, and then applied for such enlarged claims as to embrace defendant's collar, which was not covered by the claim of the original patent;* and where it is apparent, from a comparison of the two patents, that the reissue was made to enlarge the scope of the original."

This court further defined and developed intervening rights in Parker v. Yale Clock Co., 123 U. S. 87, 31 L. Ed. 100, as follows:

> "This, therefore, is a case of the amendment of a patent *so as to cover improvements not covered by the patent, and which came into use by others than the patentee and his licensee free from protection of the patent.* There is no evidence of any attempt to secure by the original patent the inventions covered by the first eight claims of the reissue, and those inventions must be regarded as having been abandoned or waived so far as the reissue in question is concerned, subject, however, to the right to have made a new application for a patent to cover them. In other words, those eight claims are not for the same invention which was originally patented."

Intervening rights were again recognized and reviewed in Topliff v. Topliff, 145 U. S. 156, 36 L. Ed. 658 at page 663. The court in this case recognized the existence of such rights as follows:

> "In the large number of cases which have come up to this court since that of Mahn v. Harwood was decided, in which reissues have been held to be invalid, it will be found that the opinion of the court was put upon the ground, either that the patentee had been guilty of inexcusable laches, usually of from four to sixteen years, or that circumstances had occurred since the granting of the original patent which made the reissue operate harshly or unjustly to the defendant in the case.

"Thus, in Matthews v. Boston Machine Co., 105 U. S. 54, 26 L. Ed. 1022, there was a delay of fourteen years; in Bantz v. Frantz, 105 U. S. 160, 26 L. Ed. 1013, a delay of fourteen years and six months; in Wing v. Anthony, 106 U. S. 142, 27 L. Ed. 110, of over five years; in Moffitt v. Rogers, 106 U. S. 423, 27 L. Ed. 76, of two years and seven months; in Gage v. Herring, 107 U. S. 640, 27 L. Ed. 601, of fourteen years; in Clements v. Odorless E. A. Co., 109 U. S. 641, 27 L. Ed. 1060, of nearly five years; in McMurray v. Mallory, 111 U. S. 97, 28 L. Ed. 365, of nine years; in White v. Dunbar, 119 U. S. 47, 30 L. Ed. 303, of five years. In Parker & W. Co. v. Yale Clock Co., 123 U. S. 87, 31 L. Ed. 100, there was a delay of one year and eight months, but it appeared that the improvements not covered by the original patent had been brought into use by others than the patentee before the reissue was applied for. In Coon v. Wilson, 113 U. S. 268, 28 L. Ed. 963, a reissue was applied for only a little over three months after the original patent was granted; but the patentee waited until the defendants produced their device and then applied for such enlarged claims as to enbrace this device, which was not covered by the claim of the original patent, and it was apparent from a comparison of the two patents that the application for a reissue was made merely to enlarge the scope of the original. * * *

"To hold that a patent can never be reissued for an enlarged claim would be not only to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee. The specification and claims of a

patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention, provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, *and no third persons have in the meantime acquired the right to manufacture or sell what he had failed to claim.* The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."

The law of intervening rights was still furtheir enunciated by the court in Dunham v. Dennison, 154 U. S. 106, 38 L. Ed. 924, in which the court said:

"After the defendant had made envelopes with a short flap of semi-circular shape and covering little more than the opening of the envelope (which, it is admitted, did

not infringe the plaintiff's patent as originally issued), the plaintiff obtained a reissue, enlarging the claims, and altering the specification throughout, so as to include an envelope with a flap of any size or shape, and to make the invention consist, not, as in the leading words of the description in the original patent, of 'an envelope with an end flap covering its side,' but in 'a tag provided with means for attaching it to the merchandise, and with an envelope or pocket to receive a bill or invoice of the merchandise.' The words of the description in the original patent were neither technical nor complicated; but they were of the simplest kind, and their meaning and scope could not have been misunderstood by anyone who read them with the slightest attention, least of all by the patentee. *To uphold such a reissue under such circumstances would be to grant a new and distinct privilege to the patentee at the expense of innocent parties, and would be inconsistent with the whole course of recent decisions in this court.*"

Citing:

Miller v. Bridgeport Brass Co., 104 U. S. 350 (26:783);

Mahn v. Harwood, 112 U. S. 354 (28:665);

Coon v. Wilson, 113 U. S. 268 (28:963);

Topliff v. Topliff, 145 U. S. 156 (36:658);

Huber v. Nelson Mfg. Co., 148 U. S. 270 (37:447);

Leggett v. Standard Oil Co., 149 U. S. 287 (37:737);
Corbin Cabinet Lock Co. v. Eagle Lock Co., 150 U. S. 38 (37:9

The doctrine of intervening rights developed by the court has been applied by the courts below as follows:

> "The owner of property may abandon it on a desert, and, turning back, retake it into his possession, and it will be his again. Even in that case, it was not his after he threw it away until he retook it, and yet he could make it his by retaking it, and then his title was as good as ever. But we are not dealing with that kind of property. The patent laws protect the exclusive right of an inventor; but the great object of those laws is to benefit the public by stimulating invention, which it is the theory of the law can be best accomplished by securing to the inventor, for a limited time, under enacted conditions, an exclusive right to the manufacture, use and sale of his invention, thereafter to be forever free to the public. Hence, in a case of abandonment or reissue, the matter is not to be likened to rights to chattels personal, for in reference to patents there is always a public equity which must not be disregarded. But for this public equity, in a case of reissue broadening the claim within the limits of the invention, the rights of an intervenor, who had in the meantime appropriated what had been inadvertently or by mistake or accident omitted from the claim, might be saved by granting the reissue,

subject to a license to the intervenor; *but applying the public equity, the court must regard the intervenor as the representative of the public and therefore whatever rights he gains the public gains.*"

Consldtd. Fruit Jar Co. v. Bellaire Stpg. Co., 27 F. R. 377-381.

"Ever since the issue of its patent for the diamond inkstand granted July 6, 1909, the defendant has done a business in the manufacture and sale of these inkstands which I have held infringed complainant's reissue patent. This business appears to have been larger in the first two or three years after the issue of the Hilles patent than it has been since. While, therefore, the defendant may not have manufactured or sold large quantities of its inkstands, it is nevertheless an incontrovertible fact that it has manufactured and sold under the Hilles patent a substantial number of inkstands, and that neither the patent nor the inkstand infringed Ashley's original patent according to the construction placed thereon by the Circuit Court of Appeals. *I can feel no doubt that a business of some importance has been built up by the defendant between the dates of the granting of the original patent and of the reissue, and that consequently intervening rights have arisen within the legal acceptation of the term.* Under these circumstances, complainants cannot be allowed to claim 'infringement by this particular defendant in continuing the manufacture and sale which it entered upon while the * * * (orig-

inal patent) was the only public announcement of complainant's alleged monopoly.'"

Ashley v. Samuel C. Tatum Co., 240 F. R. 979-982.

"Defendant next urges that there were 'intervening rights' which prevented such a reissue, and relies upon Clements v. Odorless Co., *supra*, and similar cases, as showing that the three patents issued between the date of the original issue and the date of application for reissue, sufficiently constitute or evidence those intervening rights which will bar a reissue. The reissue statute fixes no limit of time within which the application must be made, and does not specify that rights, accruing to the public or to individuals, after the first issue and before the application for reissue, shall affect the latter right. Miller v. Brass Co., 104 U. S. 350; 26 L. Ed. 783. (See Walker 4th Ed. Sec. 226), which first declared this additional condition, did not elaborate the foundation reason for so doing, but we think it must be assumed that the principle of estoppel (perhaps in favor of the public generally), is at the bottom of the rule. *By the issue of a patent, the inventor dedicates to the public everything which he does not claim as his monopoly. Upon this dedication, the public has a right to rely, and if members of the public devote time and money to the manufacture of a device which the inventor has so dedicated, or to the devising, inventing and patenting of structures which embody such a feature, it may be presumed that this is done upon the faith of the dedication; and so the inventor may not be permitted thereafter to*

enlarge his monopoly to the prejudice of these new rights,—even though, except for them, the reissue would be permissible. The settled doctrine has come to be that from a delay of more than two years, and in the absence of any sufficient contrary evidence, these fatal intervening rights (public or private) will be presumed; in the presence of less delay, they must be proved. But see White v. Dunbar, 119 U. S. 47, 52; 7 Sup. Ct. 72; 30 L. Ed. 303; and Milloy Co. v. Thompson Co. (C C. A. 6), 148 F. R. 843, 847; 78 C. C. A. 533.

Since a patent grants or creates no right to manufacture the thing patented, but only a right of exclusion (Swindell v. Youngstown Co., 230 F. R. 438—C. C. A.—(C. C. A. 6 Feb. 8, 1916), it would seem that intervening patents, not followed by manufacture, can furnish the necessary basis for this rule (in a case of less than two years' delay) only because of the effort and expense involved in making and perfecting the inventions to which they relate; in other words, because the absence of the broad claim in the earlier patent has encouraged or misled the later patentee to make and perfect an invention which he would not have undertaken if the earlier monopoly had been wider."

American Automotoneer Co. v. Porter, 232 F. R. 456-462.

"The second reissue was granted as prayed April 2, 1912. The statute (R. S. Sec. 4916; C. S. 1913, Sec. 9461) authorizing reissue when error has arisen 'through inadvertence, accident or mistake, and

without fraud or deceptive intention,' is undoubtedly intended for relief of meritorious inventors who are likely to lose their invention through some accident or mistake. When no intervening rights appear, it should be and has repeatedly been liberally construed. It may be noted that we have not here the situation presented in some of the authorities, where the reissue contains a claim which, after controversy with the Patent Office pending his earlier application, the inventor abandoned, acquiescing in its rejection. * * *

"*Before the second reissue was granted, however, and while the public was advised that the rights which complainant claimed were those only announced to the public in the first reissue, defendant began the manufacture of player piano actions with automatic regulation of the register between note sheet and tracker bar.* It used the fundamental idea of O'Connor, viz., moving the tracker bar to one side or the other, so as to keep its apertures in register with the note sheet perforations, effecting this motion by the operation of a bellows motor, setting the motor in operation by the admission of air to it through an auxiliary aperture in the tracker bar, and automatically regulating the initiation of such motion by means of the note sheet moving over the auxiliary aperture. The defendant's device, however, consisted of a single bellows motor, moved one way or the other as it was exposed to pressure or suction. This device (Exhibit N), was not covered by the first reissue, the claims of which were confined to two motors and apertures. *That defendant entered upon the manufacture*

and sale of these automatic trackers before the grant of the second reissue made public the fact that complainant was making claim to the broad invention covered by the claims here in issue is fully established. That only five of these player piano actions were actually sold is immaterial. Not only the five are free from this reissue, but the business of manufacturing and selling automatic trackers of the type shown in Exhibit N, which was entered into in the belief, warranted by complainant's conduct and mistakes, that defendant's tracker would not be challenged as an infringement under either the original patent, which had been given up, or the reissue, which did not cover it, cannot be interfered with under this second reissue."

Autopiano Co. v. Amer. Player Action Co., 222 F. R. 281.

"The claims of the original are enlarged in the reissue, and the suit rests upon the enlargement. But little more than two months, and less than three, elapsed between the date of the original and the application for the reissue. This does not seem to be too long a time to take, before proceeding for an enlargement of the claims to cover parts of the invention described but not claimed in the original, *especially when not shown to be done to cover the progress of other inventors.* The decided cases appear to warrant this course."

Hammond v. Franklin, 22 F. R. 833-836;

Miller v. Brass Co., 104 U. S. 362;

James v. Campbell, *Id.*, 371;

Clements v. Odorless App. Co., 109 U. S. 641; S. C. 3 Sup. Ct. Rep. 525;

Hartshorn v. Eagle Shade Roller Co., 18 Fed. Rep. 91.

A case which this court may desire to consider, since it was decided by this court in October, 1917, and contains extensive references to the law, is Abercrombie & Fitch v. Baldwin, 245 U. S. 198; 62 L. Ed. 240. It has been contended that in that case this court sustained a broadened reissue applied for seven years after the issue of the original. If so, the court would not only have ignored the doctrine of intervening rights but also the two year rule in Miller v. Brass Co. and the many cases in which the two year doctrine has been affirmed and applied. Even a casual study of the case shows that the court had no such intention. The court evidently considered the defendant as having been an infringer of the original patent, and the reissue as a narrowed one, as it very evidently was, since the amendment of the claim by reissue consisted in adding certain words to the original claim. The reason for the court's decision is shown by the following statement:

> "Indeed, we are of opinion, that the original patent did not need the exposition of the reissue. It exhibited an invention of merit, certainly one entitled to invoke the doctrine of equivalents."

We believe that Abercrombie & Fitch v. Baldwin is entirely inapplicable to the case at issue, but have discussed it briefly lest we should be thought attempting to avoid it.

The two year rule rests upon the equitable principle of laches and the theory of intervening rights upon the equitable principle of estoppel. In applying the two year rule, the court considers a patent invalid because the patentee was guilty of laches in waiting more than two years before applying for reissue. In the cases defining intervening rights, the court considers patents invalid because the public acted upon the abandonment or waiver of the patentee and thus established an estoppel. Both the two year doctrine and the doctrine of intervening rights rest upon sound equitable principles.

In the present case the plaintiffs having elected to claim a particular type of supporting bracket and defendants having accepted the dedication to the public of matter not claimed, and acted upon it in good faith, a clear case of equitable estoppel arises. Using the technical term commonly used to define this particular type of estoppel, the defendants may be said to have established a clear case of "intervening rights."

Intervening Rights Cannot Arise Where the Reissue Is Narrower Than the Original.

The greater portion of the apparent confusion set forth in the petition for the writ of *certiorari* arises from the fact that the petitioner's counsel ignored the fundamental distinction which must be drawn between broadened and narrowed reissues.

In a broadened reissue the patentee, having accepted a narrow patent, later decides to broaden it by reissue. Having dedicated certain rights to the public, by his failure to insist on broad claims, he later withdraws that dedication and elects to ask for a monopoly on certain features previously not claimed and therefore so dedicated.

In a narrowed reissue the patentee, having by inadvertence, accident or mistake, obtained claims which are broader than his invention, elects to surrender his broad patent and accept a narrower one. In a narrowed reissue there is no dedication to the public by failure to claim certain features in the original and therefore no estoppel which can be made the basis of intervening rights. Any one infringing the later narrow reissue must certainly have infringed the original broad patent, and he cannot claim to have been misled to his injury thereby.

The distinction in principle between broadened and narrowed reissues is well recognized in all the decisions relating to intervening rights, and if this distinction is kept in mind, the decisions on the subject are found to form a surprisingly harmonious whole. In fact, while the development of the law of reissues and intervening rights has been gradual, it has nevertheless been very consistent and logical and now rests solidly on a great mass of decisions and particularly upon the previously cited decisions of this court.

The law in regard to narrowed reissues is well stated in Eames v. Andrews, 122 U. S. 40; 30 L. Ed. 1064, in which the court said:

> "If the amended specification does not enlarge the scope of the patent by extending the claim so as to cover more than was embraced in the original, and thus cause the patent to include an invention not within the original, the rights of the public are not thereby narrowed and the case is within the remedy intended by the statute. Those cases in which this court has held reissues to be invalid were of a different character, and were cases where by the reissued patent the scope of the original was so enlarged as to cover and claim as a new invention that which was either not in the original specification, as a part of the invention described, or if described, was, by not being claimed, virtually abandoned and dedicated to public use."

"Such is not the present case. Here the amended specification does not enlarge the scope of the original invention as described in the original specification. It simply, in this respect, supplies a deficiency by describing with more particularity and exactness the means to be employed to produce the desired result."

See also:

"As will be seen, this is a case of diminished, and not enlarged, reissue. * * * Therefore the two year rule mentioned in Miller v. Brass Co., 104 U. S. 350, and Mahn v. Harwood, 112 U. S. 354, * * * should not apply."

Conroy v. Penn. Electrical & Mfg. Co., 173 F. R. 299.

"The books are full of cases where the courts have appreciated the importance of intervening rights, and have realized the injury which may or will be done to the public where, after either an unreasonable delay or a process of experimentation with court decisions, an attempt is made to broaden claims. In such instances, industry and commercial progress may be arrested if the courts were to hold to any doctrine which made it dangerous for energetic men to enter upon some well-defined field of activity only to discover subsequently that a grant theretofore given had been enlarged beyond the limits so defined. Thus it is that there is a line of cases of which Miller v. Brass Co., 104 U. S. 350; 26 L. Ed. 783, and Thompson-Houston Electric Co. v. Western Elec. Co., 158

Fed. 813; 86 C. C. A. 73, are examples. *Nowhere, however, has it been held that a reissue wherein the claims are narrowed is void for laches.*"

Motion Picture Patents Co. v. Laemmle *et al.*, 214 Fed. 787-797.

"As to reissue.—* * * It seems to us that the change effected by reissue was not a broadening of the claims, but a narrowing of them, and that, therefore, the reissue more than two years after the granting of the original patent was proper under Eames v Andrews, 122 U. S. 40; 7 Sup. Ct. 1073, 30 L. Ed. 1064. We think that Miller v. Brass Co., 104 U. S. 350; 26 L. Ed. 783, and the other cases cited do not apply. As originally drawn the claims would cover devices of the prior art; as reissued they were narrowed down to cover the unitary, positively acting, novel combination of Hazeltine."

Specialty Mach. Co. v. Ashcroft Mfg. Co., 213 F. R. 35-40.

"There is nothing in the record to show that the reissue should be held invalid for delay in applying for it, nor is the doctrine of intervening rights applicable to this case. Baldwin v. Abercrombie & Fitch Co. (D. C.), 227 F. R. 455; Motion Picture Patents Co. v. Laemmle, *et al.*, (D. C.), 214 F. R. 787. The reissue patent is valid. * * *"

Stahlbrodt Co. v. Ford Motor Co., 233 F. R. 678-682.

"The specification and claims" (of the original) "are undoubtedly broader than the invention disclosed. If the Maurer window was 'within the frame,' it was included in the Giesey claims. The patent was granted without any suggestion from the Patent Office of the existence of the Maurer device. Had it been called to Giesey's attention, a correction of this specification and claims could then have been made. Within specified limitations, that which may be done by amendment in the Patent Office pending the application may be done after the patent is granted, by a reissue. * * *

"Was it for the same invention? The device actually made and marketed is the same. The defendant admittedly infringed the invention disclosed in the drawings annexed to the original specifications. The claims of the reissue are narrower than those of the original patent, and were drawn so as to confine the claims to the specific invention disclosed in the original. No addition to, or change in, the drawings were made, and such new or substituted parts in the reissued specification in no way change the device originally described and patented. This is not the case of the securing of a reissue to broaden the claims so as to cover a device not covered in the original. The defendant is not charged with infringement of a device not embraced within the original specification, and the reissue was not sought to so enlarge the invention as to furnish the basis to sustain such a charge. Having reached the conclusion that the description contained in the original specification is sufficient to support

the claims of the reissue, I think that only a comparison of the two patents is necessary to convince that the claims of the reissue do not point out a new invention, but, by eliminating the broad features of the original patent, confine the invention to the one disclosed in the original."

Steiner & Voegtly Hdwe. Co. v. Tabor Sash Co., 178 F. R. 831-841.

An apparent exception to the rule that intervening rights cannot arise in the case of narrowed reissues is the case of Diamond Drill Contracting Co. v. Mitchell, 269 F. R. 261-263 (C. C. A. 9th Circuit). In this case the court said:

"The appellant contends that no lapse of time within the life of the patent bars an application for a reissue in a case where the application narrows the claims, rather than broadens them. It is true that some of the courts have intimated that lapse of time may be of small consequence on an application for reissue, where the original claim was too broad. But there is no room for the distinction in cases where, as here, other inventors, relying upon the state of the art, have patented new inventions and the same have gone into use. Said Judge Coxe in Carpenter Straw-Sewing Mach. Co. v. Searle (C. C.) 52 F. R. 809 (decision affirmed by the Circuit Court of Appeals, 60 F. R. 82):

'If an inventor, holding a patent with a void claim, has slept upon his rights for years until other rights have become

fixed, what possible diffierence can it make, upon principle, whether he invades those rights and secures an inequitable advantage by means of a broader claim or a narrower claim? The complainant here seeks to do by a narrower claim (assuming it to be narrower) precisely what other complainants have vainly sought to do by an expanded claim. It cannot be doubted that the attempt is as inadmissable in the one case as in the other.'

See, also, Pelzer v. Meyberg (C. C.), 97 F. R. 969, and Hoskin v. Fisher, 125 U. S. 217; 31 L. Ed. 759."

The Diamond Drill case, however, although not supported by the decisions of this and other courts dealing with the subject of intervening rights, is nevertheless not contradictory to the weight of the reported decisions on the subject, if all the facts disclosed in the reported decision in the Diamond Drill case are studied. The case was not decided upon the ground that the defendant had acquired intervening rights but upon the ground that plaintiff was guilty of laches in waiting 13 years to assert its rights.

In its original patent the plaintiff failed to indicate in any way that it considered the particular features, later claimed by reissue, were new or useful. It did not impute any particular novelty or utility to these particular features in the specification and it claimed them merely as

"means." Later after these particular features had come into general use and 13 years after the issue of the original patent it decided to claim them narrowly. The court held the plaintiff guilty of *laches*.

We do not consider that the intervening rights of defendant were in any way a factor in the Diamond Drill case which was purely a case of inexcusable neglect or laches on the part of the patentee.

An excellent reason why no estoppel or intervening rights can arise in the case of a narrowed reissue is that in such a case the applicant for the patent is not at fault. The Government of the United States has established the Patent Office, and has appointed and pays a Commissioner of Patents whose duty it is to examine applications for patents and reject claims which are too broad. If a patent issues with claims which are too broad, this is a fault of the Patent Office, which is organized and equipped to prevent this, and the applicant is therefore not at fault if he relies on the allowance of his claims by the Examiner in charge of such cases. The fault, if any, lies in the Patent Office and to penalize an applicant for a mistake made by a governmental agency would be most unjust.

Intervening Rights Are Public Rights and Invalidate the Reissue.

This raises a very interesting question, which is:

Do well-established intervening rights render a reissue patent invalid or do they simply set up a bar to recovery from the intervenor and those directly associated with him?

Or put differently:

Are intervening rights public or personal rights; that is, does the intervenor acquire rights personal to himself or does the public acquire co-extensive rights which bar any recovery from the public and, hence, render the patent invalid?

The question of whether intervening rights are personal or public is the only point in this case upon which the decisions are not definite and which warrants consideration by this court. And it seems to us that the reason this question has not been cleared up earlier is that no litigants have ever been, nor *will* any litigant ever be interested in clearing up the question of what rights the general public have in the results of litigation involving intervening rights. It is a point upon which the interests of both complainant and defendant are identical. The defendants herein, for example, are better off to be declared possessed of rights under an

otherwise valid patent than to have the Keller monopoly destroyed.

We are, however, satisfied that the logical conclusion is that defendants, as intervenors, are merely the representatives of the public and that once it is proved that defendants have intervening rights, the Keller patent, as to all except the first three claims which are the narrow claims of the original, becomes void and of no effect. What little law we can find supports this conclusion which seems to us to be logical. It seems to us also that this is a most important point to settle and one which will never come before this court more directly than in this case. Obviously, our exposition of the law would be weak and our brief ineffective if we did not say that, since the dedication of rights not claimed in the original patent was a dedication to the public, defendants in accepting and acting upon such dedication and thus setting up intervening rights acted as representatives of the public and any rights acquired by defendants herein are not personal to them but are public rights which invalidate the patent.

Intervening Rights May Arise Due to Acts Performed Prior to the Issue of the Reissue Patent, the Period of Intervention Not Being Terminated by the Mere Filing of an Application for Reissue.

The courts, in deciding cases involving intervening rights, have in general held that the intervention must occur, as it has in this case, before the owner of the patent *applies* for his reissue. In so doing they have been influenced in some degree by Miller v. Brass Co. which depends upon the equitable principle of laches. The owner of the patent, who would otherwise lose his right to reissue, must under Miller v. Brass Co. make it good within two years to prevent his laches from destroying his rights, quite independent of whether his dedication to the public is recognized and accepted.

But intervening rights arise as a matter of *estoppel*. The principle depended on is somewhat different from that in Miller v. Brass Co. and different reasoning should prevail. To prevent intervening rights from being effective, it is not only necessary that the owner of the patent overcome his laches, but it is further necesary that in some positive manner he prevent others from accepting his dedication to the public and thus prevent an estoppel arising.

If intervening rights arise due to an acceptance of the dedication to the public in the original patent, why should the time for such acceptance be terminated by the filing of an application for reissue? This filing of an application for reissue is not a public act, in the sense the issue of the original patent was. On the contrary it is an act of which the public has no notice. Even admitting that a certain defendant may have some notice by personal service or otherwise, it is evident that there is no notice to the public by the reissue applicant of his enlarged claims until his reissue patent issues. How can a private and secret application nullify the general and widespread publication of the original patent and its accompanying dedication of rights? We respectfully submit that not only should intervening rights be considered as arising from acts committed prior to the *application* for reissue but that any similar acts committed after the publication of the original patent and prior to the *issue* of the reissue should have a similar effect. In other words, it seems to us logical to hold that the public dedication of the original patent can only be withdrawn by an equally public withdrawal arising from the reissue.

In the case now before this court, this question perhaps does not arise directly, since our clients were fully embarked in the manufac-

ture of the alleged infringing devices considerably prior to the date of application for reissue. It arises indirectly, however, since even if the court were to hold that the evidence is insufficient to show manufacture before the date *of application* for reissue, the evidence is abundantly sufficient to show that our clients were embarked in such business long prior to the date *of issue* of the reissue patent.

There Is No Positive Right of Reissue Which Must Be Respected.

The plaintiffs in the courts below and in their petition for writ of *certiorai* laid great stress on the fact that Keller had a right to reissue his patent with broader claims and that the public was charged with knowledge of this fact and that defendants herein went ahead with their manufacturing at their peril.

This legal theory is based upon a line of decisions starting apparently with Crown Cork & Seal Co. v. Aluminum Stopper Co., 108 F. R. 845. The syllabus in this case reads as follows:

> "Within two weeks after the issuance of a patent to defendants they were notified by complainant of his claim that it was an infringement of a patent to him just previously issued. Within six months thereafter complainant applied for a reissue, which, after a contest by defend-

ants, was granted. Held, that defendants were presumed to have knowledge of complainant's right under the law to a reissue, and, as they were also familiar with plaintiff's invention, they proceeded to manufacture under their patent at their peril, and could not claim that complainant was estopped to assert his rights under his reissued patent."

This syllabus is misleading and incorrect.

The only portion of the decision relating in any way to this question is found on page 860 and is as follows:

> "We are further of opinion that there has been in this case no unreasonable delay *and no intervening right* which forfeits or waives the right of reissue covered by the statute. The Hall patent was applied for in February, 1894, and the application for it could not have been induced by the limitations in the claims of the Painter patent, and there is no reason to believe that the course of the parties claiming under it was in any respect different from what it would have been if the original had been precisely in the terms of the reissue. Under all the circumstances of this case, the application for reissue was made within a reasonable time. No notice of any manufacture, use, or sale under the Hall patents was brought to the knowledge of Painter before his application for reissue, *and there was no manufacture or sale or publicity such as to import notice to him.* The case would be different if Painter had unreasonably delayed to assert

his rights to reissue after such notice was brought home to him, *and where his silence and inaction had misled other parties to their injury;* and the fact that the original patent contained a statement of his invention which covered the subject-matter of the reissued claim, and that a reissue to fully secure the invention disclosed was authorized by law, was sufficient notice that this patent was subject to such right of reissue, which right was liable to be exercised at any time at least within two years. The spirit and terms of the law authorizing reissues would be defeated, and the obvious purpose of its enactment would be ineffectual, if we applied to this case those restrictions which some of the decisions apply to cases where there has been long delay in the application for reissue, and the obvious purpose of such applications has *been to appropriate subsequent independent inventions not originally disclosed in the patent.*"

It is evident that in that case the only basis of intervening rights was a patent which issued before the reissue was applied for. As the court specifically says, "There was no manufacture or sale or publicity such as to import notice to him."

It is evident, therefore, that the syllabus is incorrect. The court did not hold that any one who manufactures devices prior to the application for reissue does not acquire intervening rights, but held that no one can start to manufacture *after the allowance of reissue* and then

set up *as a defense* a patent owned by the infringer and issued prior to the application for reissue. This meaning is fully supported by the language and facts of the case. When so understood, this case is in full accord with the other cases cited herein. In other words, the Crown Cork & Seal Co. v. Aluminum Stopper Co. case simply means that the application for or issue of a patent is no proper basis for intervening rights, a conclusion with which we fully agree and which we have discussed elsewhere in this brief.

We find this "right of reissue" referred to in Bertels v. Trethaway, 175 F. R. 971, but in that case it is evident the defendants infringed the original patent and, as well stated in that decision, they were not misled to their hurt. Intervening rights cannot arise from acts of infringement of the original patent, as an *infringer* of the original patent cannot be said to be taking advantage of any dedication to the public.

We also find this right of reissue raised in Weber v. Automobile & Accessories Mfg. Co., 190 Fed. 189. In that case the District Judge said, on page 193:

> "Defendant says Norwood acquired rights in that time of which the reissue cannot deprive him. It says it has succeeded to those rights. The defendant has

> failed to prove beyond reasonable doubt the existence of the facts upon which such rights rest."

It is evident, therefore, that the learned judge recognized that such facts, if proved, would have raised such rights and defeated the reissue.

Probably the judges in the last two cases in some measure misunderstood the Crown Cork & Seal Co. case which they quote, due to the misleading wording of the syllabus.

An applicant for patent has imposed upon him certain formal obligations and two main duties, namely, he must fully *disclose* the invention and he must *particularly point out and distinctly claim* the invention. The latter requirement is for the purpose of informing the public what the bounds of his monopoly are so that they may avoid infringement.

It is, however, urged by the plaintiff herein that the patentee has, in addition to the tangible and definite monopoly set up by the claims, a further undefined, indefinite, and intangible monopoly bounded only by the aggressiveness of his attorney in some future application for reissue and the resistance of the Patent Office thereto. This theory would set up an indefinite and uncertain situation which it is the aim of the patent laws to avoid. There is laid upon the applicant the duty of particularly pointing

out and distinctly claiming his invention. Why should this be necessary if at any time within two years after the issue of his patent he has the right to claim anything that can be supported by his disclosure and the state of the art?

In considering patent cases, as in all cases, we should at all times keep in view those constitutional provisions upon which our legal system rests. All patent legislation rests upon Article I, Section 8, of the Constitution which provides that "The Congress shall have power to promote the progress of Science and Useful Arts, by securing for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."

It is evident that in the Constitution the paramount rights of the public are recognized.

We respectfully submit that the progress of neither Science nor the Useful Arts will be promoted by any rule under which a patentee shall be given two years after the grant of his patent to decide what claims he shall ask for. Any such rule would throw the whole industrial system of the country into chaos. No manufacturer would know what might be finally claimed in a later reissue and all industry would be blighted by the sinister shadow of this right to reissue. While this right to reissue exists, it is extinguished by any intervening rights that may arise.

It is also evident that this so-called right of reissue, depending as it does upon the apparently misunderstood Crown Cork & Seal Co. decision, has no real basis in law and is opposed by all the decisions of this court quoted above.

Patents Applied for, or Issued During the Period of Intervention, Are Not a Recognition of Any Dedication to the Public in Prior Patents and Form No Substantial Basis for Intervening Rights.

The interesting question arises from a consideration of Crown Cork & Seal Co. v. Aluminum Stopper Co., as to whether the application for, or even the issue of, a patent disclosing structure not infringing the claims of an original patent but infringing the claims of a later applied for reissue, will raise intervening rights.

We think the learned judges who decided Crown Cork & Seal Co. v. Aluminum Stopper Co. were very logical and that the application for and issue of such a patent does *not* raise intervening rights. It is obvious to us that the mere making of an application for an improvement patent is not such an acceptance of a dedication to the public as will raise intervening rights. By filing such an application, the applicant for such an improvement patent does not

signify that he has considered the claims of the original patent in any way, or that he intends to rely in any way on the limitations thereof. He might make such an application quite regardless of whether the claims of the original were broad or narrow. Such an application does not involve any consideration of the rights of the owner of the original patent, but merely the assertion of a new right to an improvement thereon. So while there are cases that consider the application for or issue of such improvement patents as setting up intervening rights, it is evident that this view is not logical.

Our opinion on this point is sustained by American Automotoneer Co. v. Porter, 232 F. R. 456, in which it was said:

> "In this case, each of these three patents was applied for before the issue of the Weyand original, and so, at the time of such original issue, was a pending application showing an invention then completed and reduced to practice. Such patents, which merely go to issue in the interval, cannot raise the estoppel upon which this doctrine must at last depend—though it may be called 'public policy.' There is no evidence that the inventors under any one of them manufactured, and so they do not seem to have done anything in reliance upon the apparent dedication made in the first patent, excepting merely that they paid their final fees."

The Fact That an Applicant Misunderstood His Attorney as to the Scope of the Claims is Not in Reality Inadvertence, Accident, or Mistake Sufficient to Justify Reissue.

The Keller reissue was based upon the following statement:

> "And that such errors arose through a misunderstanding between applicant and his attorney; that applicant had fully described to his attorney the several features of his invention now claimed in this present application, and was informed by his attorney that the claims as allowed covered the general and broad feature of supporting the shield by a rod and a double hinged supporting member and that applicant relied on such statement as he understood it at that time; whereas it now appears to applicant that such statement was a mistake or that he misunderstood his attorney."

The reissue statute is quite definite in requiring "inadvertence, accident, or mistake" as a pre-requisite to reissue. Now, since few inventors are skilled in patent law, it is evident that many of them can *conscientiously* take oath to allegations similar to those made by Keller and that any of them can *safely* do so since what a man *understands* a patent to mean is a matter that cannot be successfully disputed. This being the case, it is evident that substantially every patent *can* be reissued with broader claims.

Now in ordinary matters there is an identity of responsibility between any litigant and his attorney which cannot be disputed. An unsuccessful litigant, who asked for a new trial because he did not understand the full force of stipulations entered into by his attorney, would be given scant consideration. The sole purpose of allowing any person an attorney in any proceeding is to supply him with a skilled advocate to supply the clients deficiencies. In no other proceeding that we are aware of can the personal lack of knowledge of the law of a party be availed of where an attorney is relied upon. It seems to us that, since substantially every applicant for patent is unskilled in patent law and hence hires an attorney who is, allegations that the applicant is unskilled or that he misunderstood his attorney are a very unsubstantial basis upon which to allege "inadvertence, accident, or mistake." In fact, we seriously question whether any patent ever issues where such allegations could not be made or in which such allegations, if made, could be disproved. This being the case, the inadvertence, accident, or mistake of the statute becomes a mere legal fiction. We respectfully submit that any reissue upon such grounds is not in accordance with the statute, or the decisions relating thereto, and that such a reissue is illegal

and void. This is in accordance with the plain words of Miller v. Brass Co. previously quoted herein.

The Keller Reissue Patent Contains a Needless Multiplication of Nebulous Claims and is Therefore Void.

This defense was raised in the courts below but since both courts felt that the defense of intervening rights was complete, this minor defense was overlooked. The Keller invention is a simple device consisting of a plate of glass and a simple hinge. Yet the ingenuity of the patent solicitor has expanded the original patent into a reissue containing twenty-three claims. All of the new claims, numbered from 4 to 23, are exceedingly indefinite and "nebulous." The court said, in Carlton v. Bokee, 17 Wallace 463, 21 L. Ed. 517, that:

> "We think it proper to reiterate our disapprobation of these ingenious attempts to expand a simple invention of a distinct device into an all-embracing claim, calculated by its wide generalizations and ambiguous language to discourage further invention in the same department of industry and to cover antecedent inventions. Without deciding that a repetition of substantially the same claim in different words will vitiate a patent, we hold that where a specification by ambiguity and a needless multiplication of nebulous claims is calculated to deceive and mislead the public, the patent is void."

This decision is quoted by Walker, section 455, who says:

> "It is a defense of decided merit, aimed by the policy of the law at nebulous claims. The courts have not heretofore gone so far in upholding this defense as the statute would justify."

In Robinson v. Tubular Woven Fabric Co., 248 F. R. 541, the court said:

> "The duty rests upon the courts to guard the rights of the public against that form of unjust monopoly which may result from sustaining highly abstract claims. The language of the Supreme Court in Carleton v. Bokee, 17 Wall 463-471, 21 L. Ed. 517, should be always in mind. * * * An attempt to save such claims by a beneficent interpretation is not only contrary to well established patent law but a practical mistake. Patent claims are advisedly made by skilled solicitors and if they choose to claim abstractions or high generalizations, they must stand by them."

See, also:

> Edgarton v. Furst, 9 Fed. 457, and
> American Bell Telephone Co. v. National Telephone Manufacturing Co., 109 F. R. 976, at page 1043.

Nebulous claims are claims which are highly abstract or general, claims in which all inclusive terms are used like means, members, device, element, etc. If the court will read a few of the

last nineteen claims of the reissue, those being the new claims, it will be evident that these claims are of that character, that is, that they are highly abstract or general, or in the words of the decisions, they are nebulous. There are twenty-three claims in the reissue which, considering the simplicity of the structure, is certainly an outrageous multiplicity.

We regard the Carlton v. Bokee ruling as a salutary one and believe a reiteration of it by this court would have an excellent effect both on the Patent Office and certain solicitors. The patent statute says that an applicant "must particularly point out and distinctly claim" his invention. This, Keller does not do and upon these grounds alone the patent should be declared invalid.

When a solicitor presents and when the Patent Office allows a patent such as the Keller reissue No. 14,919, with indefinite and nebulous claims, they impose an unnecessary burden on the public and upon the courts, which must consider and interpret such patents. They render uncertain what should be certain. Such patents should be condemned and the practice of issuing them should be stopped.

Our Client's Intervening Rights are Shared in by the Public and the New Claims in the Keller Reissue Patent are Void.

Having considered the state of the law of reissues, we can now consider how the law applies to the present case.

This case comes up upon a writ of certiorari upon the sole ground of confusion of law on a question of national importance. The trial judge and the three circuit court judges have considered the facts and they are unanimous as to these facts.

The decision of the Circuit Court of Appeals is found in 287 F. R. 838, and quotes with approval the memorandum opinion of the district judge. The opinion of the Circuit Court of Appeals reads as follows:

> "That there is nothing of a pioneer nature in Keller's device is abundantly shown by the numerous exhibits appearing in the record of windshields and deflectors, of one kind and another, attached to automobiles long before Keller entered the field. Both his drawings and specifications show that his shield is attached to the machine by brackets that run up and down the glass, holding it at the top and bottom, whereas the appellee's device holds the glass by means of a fixture attached to the face of the glass and which does not extend to either of its ends. That for one device to be the equivalent of another it is essential that the former must perform the same

function of the latter in substantially the same way is thoroughly settled law. Machine Co. v. Murphy, 97 U. S. 120, 125, 23 L. Ed. 935; Werner v. King, 96 U. S. 218, 230, 24 L. Ed. 613; Simplex Window Co. v. Hauser Reversible Window Co., 248 Fed. 919, 926, 161 C. C. A. 37; Dey Time Register Co. v. Syracuse Time Recorder Co. (C. C.), 152 Fed. 440, 451; Walker on Patents, Sec. 348; Curtis, Patents (4th Ed.), Sec. 310.

"The evidence shows that, prior to any knowledge on their part of the Keller patent, the appellees had been working on their device, and had made and sold a few of them, but subsequently learned of and became familiar with the original Keller patent, and before proceeding with the manufacture and sale of their own device, and prior to the making of the application for the reissued Keller patent, they applied to the attorneys who procured the original Keller patent for information as to whether their device was an infringement upon that of Keller, saying that they did not wish to infringe, and, being told that it would not be an infringement, they proceeded with the manufacture and sale of their own on a substantial basis. We therefore think it clear that the appellees had and have such intervening rights as were properly protected by the court below. See Coon v. Wilson, 113 U. S. 268, 5 Sup. Ct. 537, 28 L. Ed. 963; Topliff v. Topliff, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658; Dunham v. Dennison, 154 U. S. 103, 111, 14 Sup. Ct. 986, 38 L. Ed. 924; Auto-Piano Co. v. American Player Action Co., 222 Fed. 276, 138 C. C. A. 38.

"The decree of the court below is affirmed."

We assume that this court is willing to accept these facts, which are abundantly supported by the evidence.

Upon the facts our clients have an unusually strong case of intervening rights. They were experimenting prior to the issue of original patent; they investigated the rights conferred by the original patent and were advised they did not infringe and they were actively in business prior to application for reissue; they did not, in fact, infringe the original and they do, in fact, infringe the reissue. This, to our mind, is a perfect case of intervening rights.

In the District Court, the plaintiff attempted to "declare" upon claims 1, 2, 8, 17, 21 and 23. Both the District Court and the Circuit Court of Appeals ignored this declaration. It is obvious that claims 1 and 2 of the Keller reissue patent No. 14,919 are not infringed, since our clients do not have brackets engaging the transparent shield member at its upper and lower ends, as specified in claims 1 and 2. That is, they do not have brackets 17 and 18 which engage the ends of the glass member 14. See Fig. 5 of the Keller reissue patent No. 14,919. It is also obvious that our clients do not infringe claim 3 which is specific to the structure

shown and this claim 3 was not sued on. Claims 1, 2 and 3 of the reissue are therefore not infringed and so far as we know are valid.

Claims 4 to 23 of the reissue are not found in the original. They all read substantially on the intervening device of our clients and are therefore invalid.

Conclusions.

In conclusion we would say that although we have spent a great deal of time on the question of intervening rights and studied several hundred decisions in relation thereto, we find astonishingly little confusion in these decisions. If all the facts are considered in each case, there is substantially *no* confusion. The decisions flow naturally one from another and form a coherent and logical whole.

In Miller v. Brass Co., this court applied the equitable principle of laches and thus curbed a great national abuse of the power to reissue. In Coon v. Wilson, Dunham v. Dennison and other cases cited herein, it has applied the principle of estoppel and further curbed the same abuse. Neither the two-year rule nor the rule of intervening rights has any statutory foundation. They rest upon broad equitable principles and are essentially the product of this court. They are definite, practical, and certain, and their value to the country has been incalculable.

Owing to the growth of our nation, it has become impossible for this court to regularly hear patent appeals. Only an occasional case can come before this tribunal. The days when decision after decision in patent cases flowed from this court are forever gone. The patent bar must in a large measure now depend upon the decisions of the lower courts.

But it will be sometimes necessary that this court consider patent cases. Our law is a living thing and as it develops through the hard labor of our judges, it is desirable that this court, from time to time, shall clarify and explain it. Such a time has come in the law of reissues.

There is an opportunity for the court to do a great public service in this case by a lucid exposition of the law of intervening rights. It is not necessary, as it was in Miller v. Brass Co., to lay down any broadly new principle. All that is needed is a definite and plain restatement of principles already developed and applied. The large number of reissues and the great amount of patent litigation thereon shows the importance of the subject. It is probable that a decision of this court will materially reduce both.

We think this court should hold:

First, that intervening rights arise, wherever any person accepts the dedication to the public of matter shown but not claimed in any patent,

this acceptance being evidenced by acts which infringe a later reissue but do not infringe the original patent.

Second, that the acceptance of the dedication must be by acts which evidence a plain intention to rely on the dedication and that the mere application for, or issue of, improvement patents does not disclose such an intention.

Third, that the dedication to the public, being made in official publications by the issue of the patent, can only be nullified by a similar publication of the reissue and acts prior to the date *of reissue* are available to prove intervening rights.

Fourth, that the intervenor in accepting the dedication to the public in the original patent and acting upon it, acts as a representative of the public and the intervening rights so set up are rights in which the entire public shares, the effect of such rights being to invalidate any claims in the reissue that are broader than the original claims and infringed by the acts of the intervenor.

Fifth, that the two-year rule does not apply to and no intervening rights can arise in the case of a narrowed reissue.

Sixth, that the Keller reissue patent No. 14,919 is invalid as to the new claims inserted

by reissue, that is as to claims 4 to 23 inclusive, due to intervening rights.

Seventh, that, in addition, the entire Keller patent is invalid since it contains a multiplicity of nebulous claims.

Respectfully submitted,

FORD W. HARRIS.

Counsel for Respondents-Defendants.

Los Angeles, California, Jan. 31, 1924.